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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/882,709	06/15/2001	Dennis J. O'rear	005950-716	9362

7590 03/10/2003

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EXAMINER

MCAVOY, ELLEN M

ART UNIT	PAPER NUMBER
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1764

DATE MAILED: 03/10/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/882,709

Applicant(s)

O'REAR, DENNIS J.

Examiner

Ellen M McAvoy

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-27 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2. 6) ☐ Other: .

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Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Berlowitz et al (6,080,301) or Berlowitz et al (6,165,949), in combination with Smalheer et al.

The Berlowitz et al ["Berlowitz"] references disclose premium synthetic lubricating oil basestocks having a high viscosity index (VI) and low pour point which contain at least 95% by weight of non-cyclic isoparaffins. The lubricant basestocks are produced by hydroisomerizing waxy, Fischer-Tropsch synthesized hydrocarbons. See column 1, line 8 to column 2, line 14 of Berlowitz '301 and column 1, lines 5-65 and column 4, lines 23-28 of Berlowitz '949. The lubricant basestocks contain sulfur, nitrogen and metals in amounts of less than 1 ppm by weight. The examiner is of the position that these premium synthetic basestocks clearly meet the limitation of component (a) of the claims, the Fischer-Tropsch product. The lubricant basestocks of the Berlowitz references may be mixed or blended with one or more additional basestocks selected from the group consisting of (a) hydrocarbonaceous base stock, (b) a synthetic base stock, and mixtures thereof. Typical examples include base stocks derived from (i) poly-alpha-olefins, (ii) conventional mineral oils, (iii) mineral oil slack wax hydroisomerates, and mixtures thereof. See column 2, lines 25-44 and column 5, top of Berlowitz '301 and column 5, lines 43-56 of Berlowitz '949. The examiner is of the position that these additional base stocks meet

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the limitation of the “petroleum-derived hydrocarbonaceous product” of the claims. Berlowitz also allows for the addition of conventional additives such as antioxidants to the compositions. See column 4, lines 30-45 of Berlowitz ‘301. Smalheer et al [“Smalheer”] is added to show that phenolic compounds and diphenylamine compounds are conventional antioxidants in lubricating oil compositions. Thus, the examiner is of the position that the premium basestock blends of the Berlowitz references clearly meet the limitations of the method of inhibiting oxidation of a Fischer Tropsch product by blending with a petroleum-derived hydrocarbonaceous product and of the blended hydrocarbonaceous products of the claims.

Claim Rejections - 35 USC § 103

Claims 1-27 are also rejected under 35 U.S.C. 103(a) as being unpatentable over Wittenbrink et al (6,332,974).

Wittenbrink et al [“Wittenbrink”] disclose a wide-cut lubricant base stock having a low pour point and high viscosity index (VI) which is made by hydroisomerizing and then catalytically dewaxing a waxy Fischer-Tropsch synthesized hydrocarbon fraction. The base stock comprises at least 95% by weight of non-cyclic isoparaffins. See column 4, lines 5-38. The base stocks of Wittenbrink may also be blended with an additional lubricant base stock which may be selected from the group consisting of (i) a hydrocarbonaceous base stock, (ii) a synthetic base stock and mixtures thereof. See column 4, lines 33-50. Wittenbrink teaches that by “hydrocarbonaceous” it is meant a primarily hydrocarbon type base stock derived from a conventional mineral oil, shale oil, tar, coal liquefaction, and mineral oil derived slack wax. The

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examiner is of the position that these additional base stocks meet the limitation of the "petroleum-derived hydrocarbonaceous product" of the claims. Wittenbrink also allows for the addition of conventional additives such as antioxidants to the compositions. Suitable antioxidants include hindered phenols and hindered aromatic amines. See column 4, lines 50 to column 5, line 38. Thus, the examiner is of the position that the premium basestock blends of Wittenbrink clearly meet the limitations of the method of inhibiting oxidation of a Fischer Tropsch product by blending with a petroleum-derived hydrocarbonaceous product and of the blended hydrocarbonaceous products of the claims.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-27 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-12 of copending Application No. 09/966,298. Although the conflicting claims are not identical, they are not

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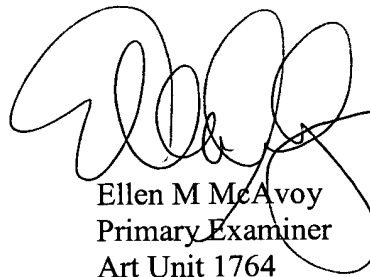
patentably distinct from each other because the lubricant base oil blends which comprise Fischer-Tropsch synthesized hydrocarbons and additional basestocks may be the same.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ellen M McAvoy whose telephone number is (703) 308-2510. The examiner can normally be reached on M-F (7:30-5:00) with alt. Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenn Caldarola can be reached on (703) 308-6824. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.



Ellen M McAvoy
Primary Examiner
Art Unit 1764

EMcAvoy
March 5, 2003